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Patent
Attorney's Docket No. 003300-790

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 07 2003

TECH CENTER 1600/2900

In re Patent Application of)
Asa BERGLUND) Group Art Unit: 1647
Application No.: 09/869,269) Examiner: Jegatheesan Seharaseyon
Filed: July 11, 2001) Confirmation No.: 2429
For: MODIFICATION OF INTERFERON)
ALPHA PRODUCTION)

RESPONSE TO RESTRICTION REQUIREMENT TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed is a Response to Restriction Requirement for the above-identified patent application.

- ☒ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (2814) ☐ \$110.00 (1814) to cover the requisite Government fee are also enclosed.
- ☒ Also enclosed: Information Disclosure Statement Transmittal Letter; Information Disclosure Statement; Form PTO-1449 w/19 references.
- ☒ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$375.00 (2801) ☐ \$750.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☒ No additional claim fee is required.

Response to Restriction Requirement Transmittal Letter

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☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

☐ A claim fee in the amount of \$_____ is enclosed.

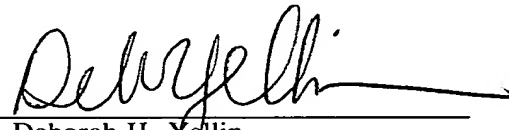
☐ Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:


Deborah H. Yellin
Registration No. 45,904

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(703) 836-6620

Date: January 2, 2002



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Patent

Attorney's Docket No. 003300-790

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
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Application No.: 09/485,345) Examiner: Jegatheesan Seharaseyon
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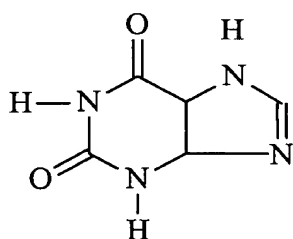
TECH CENTER 1600/2900

Sir:

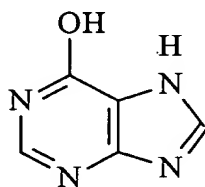
In complete response to the Restriction Requirement set forth in the Official Communication mailed on October 1, 2002 (Paper No. 7), Applicant hereby elects with traverse the claims of **Group I** (Claims 1-5, 8-16 and 20), which are drawn to a process for production of α -interferon using theophylline as an enhancing agent. Applicant respectfully reserves the right to pursue any non-elected subject matter in a divisional or continuation application, if it is not rejoined to the subject matter elected herein.

The Office Action asserts that the claims lack unity of invention under PCT Rules 13.1 and 13.2. Applicant submits that unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. 37 C.F.R. § 1.475. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.*

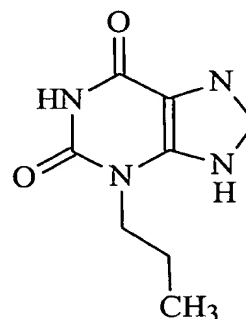
Applicant respectfully submits that all of the claims of the present invention, in the three cited Groups, form one single invention concept and share a technical relationship. Specifically, all of the compounds recited as potential enhancing agents share structural features. Applicant notes that all compounds recited by the claims as enhancing agents are structurally related, as they all have a common function according to the invention and are structurally related, since they share a pyrimidine ring structure, substituted with a hydroxy/keto group. For example, regarding xanthine and its derivatives of claim 1(ii)(a), *i.e.* xanthine, theophylline, theobromine, enprophylline, hypoxanthine, and 8-phenyltheophylline, Applicant notes the structural similarity between these compounds, as illustrated below.



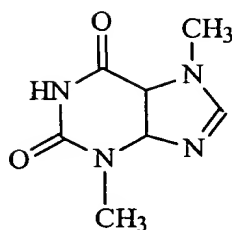
xanthine



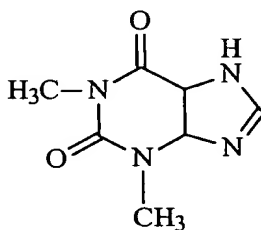
hypoxanthine



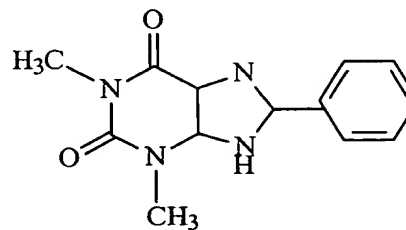
enprophylline



theobromine



theophylline



8-phenyltheophylline

Applicant submits that xanthine, and the other xanthine derivatives, are structurally highly similar to theophylline. Accordingly, a special technical feature exists at least with all of the groups of claims. Thus, Applicant respectfully requests rejoinder of all groups of claims and examination of all compounds recited by claim 1. Alternatively, if all Groups are not rejoined, Applicant requests that all xanthines and/or all pyrimidinols and/or pyrimidinones be examined, rather than one specific type of xanthine, pyrimidinol or pyrimidinone.

To this end, Applicant also notes that it appears that rather than requiring the election of one of the genres of enhancing agent specifically recited by claim 1 (for example, xanthine, pyrimidinol or pyrimidinones, *see* claim 1, element 1(i)(a)), the Office Action appears to be requiring an election of a specific species from one of these groups. If this is the case, Applicant requests clarification, as well as the examination of all xanthines, pyrimidinols or pyrimidinones upon allowance of one type.

For purposes of clarity, Applicant notes that the above discussion of the technical features of the enhancing agent compounds recited in element 1(ii)(a) of claim 1 does not apply to the structural and other features of the organic solvents recited in element 1(ii)(b). Applicant notes that the current restriction requirement does not apply to the compounds recited in element 1(ii)(b) of claim 1.

Finally, as Applicant has traversed the rejection, Applicant notes for the record the following regarding the instant restriction requirement. Under M.P.E.P. § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct

(M.P.E.P. § 806.05). However, the second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent and distinct inventions. Furthermore, the Office has not set forth an explanation of how a search of the claimed invention would be burdensome. Accordingly, Applicant asserts that a proper restriction under M.P.E.P. § 803 has not been set forth with regard to the originally presented claims. The restriction should be withdrawn or, at the very least, reconsidered.

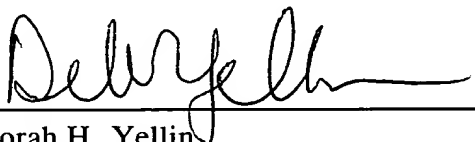
CONCLUSION

Applicant submits that the present application is fully in condition for examination. An early examination on the merits is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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